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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,540	10/11/2005	Shigeru Tanaka	81844.0044	2300
26/021 7590 05/21/2008 HOGAN & HARTSON LLP. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067				
EXAMINER NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
05/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,540

Applicant(s)

TANAKA ET AL.

Examiner

Patrick D. Niland

Art Unit

1796

Period for Reply -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008 and 26 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-20 and 32-42 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 21-29 and 31 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/26/08 has been entered.

The amendment of 2/19/08 has been entered. Claims 1-5 and 7-42 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7, 21-29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-203467 Fumihiro et al., Machine translation thereof provided and referenced below.

Fumihiro discloses a composition and circuit board made therewith containing polyimide made with the instantly claimed dianhydrides (note particularly ODPA, BTDA and BPDA of lines 1-5 of the "EXAMPLE" section), epoxy resin, and phenol resin in the instantly claimed amounts (note the lower amount of polyimide resin of the abstract, claims 2-3, the upper amount of epoxy resin of the abstract, claim 2, and the upper amounts of the epoxy resin hardeners,

which include phenol resins, of claim 2, “Detailed Description”, section [0010] where the upper amounts of epoxy and hardener are used and the lower amounts of polyimide are used, and [0019]-[0020], particularly the lower amounts of polyimide and upper amounts of epoxy and phenol hardener of claims 2-3).

See the abstract, claims, “Detailed Description”, sections [0001], [0010] where the upper amounts of epoxy and hardener are used and the lower amounts of polyimide are used, [0014], [0019]-[0020], particularly the lower amounts of polyimide and upper amounts of epoxy and phenol hardener of claims 2-3, and the remainder of the document. It is not seen that the circuit board of the reference does not necessarily contain a layer having the properties of claim 23 necessarily and inherently since the adhesive layer of the reference is that of the instant claims and is therefore expected to have the same properties as the compositions of the instant claims.

5. Claims 1-5, 7, 21-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-203467 Fumihiro et al., Machine translation thereof provided and referenced below.

Fumihiro discloses a composition and circuit board made therewith containing polyimide made with the instantly claimed dianhydrides (note particularly ODPDA, BTDA and BPDA of lines 1-5 of the “EXAMPLE” section), epoxy resin, and phenol resin in the instantly claimed amounts (note the lower amount of polyimide resin of the abstract, claims 2-3, the upper amount of epoxy resin of the abstract, claim 2, and the upper amounts of the epoxy resin hardeners, which include phenol resins, of claim 2, “Detailed Description”, section [0010] where the upper amounts of epoxy and hardener are used and the lower amounts of polyimide are used, and

[0019]-[0020], particularly the lower amounts of polyimide and upper amounts of epoxy and phenol hardener of claims 2-3).

See the abstract, claims, "Detailed Description", sections [0001], [0010] where the upper amounts of epoxy and hardener are used and the lower amounts of polyimide are used, [0014], [0019]-[0020], particularly the lower amounts of polyimide and upper amounts of epoxy and phenol hardener of claims 2-3, and the remainder of the document. It is not seen that the circuit board of the reference does not necessarily contain a layer having the properties of claim 23 necessarily and inherently since the adhesive layer of the reference is that of the instant claims and is therefore expected to have the same properties as the compositions of the instant claims.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed combinations of ingredients and amounts thereof because they are encompassed by the reference and would have been expected to give the properties described in the reference.

6. Claims 8-20 and 32-42 are allowable over the prior art. US Pat. No. 5639808 Coggio et al. is representative of the closest prior art but does not disclose the inventions of the instant claims 10-20 nor is proper motivation seen to modify the prior art considered into the instantly claimed invention.

7. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There is not motivation in the prior art considered to modify the teachings of the prior art into the instantly claimed invention of claim 30.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796